

## **Remarks**

### **1. Summary of the Office Action**

Claims 1-13 and 30-32 are pending, of which claims 1, 6, 10, and 12 are independent. In the Office Action mailed March 3, 2005, the Examiner rejected claims 1-13 and 30 under 35 U.S.C. §101 as being directed toward non-statutory subject matter. In addition, the Examiner rejected claims 1-13 and 32-34 as unpatentable under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,415,438 ("Blackketter") in view of the "official notice" that a broadcast medium comprises advertising.

### **2. Status of the Claims**

Applicant has amended claims 1, 2, 6, 7, 10, 11, 12, 13, 30, and 31 and cancelled claim 33. Now pending in the application are claims 1-13, 30-32.

### **3. Response to §101 Rejection of Claims 1-13 and 30**

The Examiner rejected claims 1-13 and 30 under 35 U.S.C. §101 as being directed toward non-statutory subject matter. Specifically, the Examiner asserted that the claims contain no technical subject matter and may be carried out by the human mind along with a pencil and paper.

Each claim includes a number of technical limitations. For instance independent claims 1 and 6, as amended, include the step of "sending an advertising authorization request via a telecommunications network to the subscriber terminal." Similarly, independent claims 10 and 12, as amended, includes the step of "retrieving a reply to an advertising authorization request from computer readable memory, the reply authorizing at least one advertisement to be sent to the subscriber terminal." Such steps can only be accomplished through a device or system. Thus, each independent claim and their

dependents are clearly within the technical arts and directed toward statutory subject matter.

#### **4. Response to § 103 Rejection of Claims 1-13 and 32-34.**

The Examiner rejected claims 1-13 and 32-34 under 35 U.S.C. §103(a) as being unpatentable over Blackketter in view of the "official notice" that a broadcast medium comprises advertising. Under MPEP § 2143, a prima facie case of obviousness over a combination of references can be established only if the cited references disclose or suggest all of the claim limitations. Applicant respectfully traverses the obviousness rejections of the remaining claims because Blackketter in view of the aforementioned "official notice" fails to disclose or suggest every element of any of these claims.

##### **a) The Claimed Invention**

Applicant's independent claim 1 is directed to a method of advertising on a subscriber terminal. As recited in claim 1, an advertising authorization request is sent to the subscriber terminal via an electronic communications network. Then, a reply to the authorization request is received from the subscriber terminal – the reply including an authorization for an advertisement to be sent to the subscriber terminal. In response to the authorization, the advertisement is sent to the subscriber terminal after a triggering event occurs.

Independent claims 6 and 12 include the authorization request and/or reply and also require displaying the advertisement on the subscriber terminal when at least one triggering event occurs.

Regarding the authorization, dependent claims 3 and 8 provide that the advertising authorization request includes a “user-selectable option” for authorizing an advertisement.

Dependent claims 2, 7, and 11, as amended, define the triggering event as when the subscriber terminal is either idle or substantially stationary. Dependent claims 5 and 9 further limit the method by defining the triggering event as when the subscriber terminal is *both* idle *and* substantially stationary.

**b) The Blackketter Reference**

Blackketter provides a disclosure of a television trigger having a time attribute. According to the specification, the Blackketter trigger is an executable message that is received at a receiver unit and then executed at a specified time. *See, for example,* Blackketter at ¶9 and Fig. 4.

**c) Blackketter Does Not Provide An Advertising Authorization Request Or Ensuing Reply**

Each independent claim of the present invention includes sending an advertising authorization request to a subscriber terminal and/or receiving (or retrieving) a reply to the advertising authorization request. Generally the advertising authorization is used to determine whether an advertisement may be sent to the subscriber terminal. These authorization functions may provide a mechanism to help ensure that unauthorized advertisements, such as spam, are not sent to the subscriber terminal.

Neither the authorization request nor the reply are disclosed or suggested by Blackketter. Rather, Blackketter assumes that a trigger message will be sent in every instance. For example, each and every flow diagram shown in Blackketter begins with

the receiver unit receiving the trigger. Figs. 3, 7, 10, 13. In Blackketter, there is no determination of whether an advertisement (or broadcast) would be authorized by the subscriber terminal.

Because each independent claim of the present application includes sending an advertising authorization request to a subscriber terminal and/or receiving (or retrieving) a reply to the advertising authorization request, Blackketter cannot obviate those claims or their dependents.

**d) Blackketter Fails to Provide a “User-Selectable Option” for Authorizing an Advertisement**

Dependent claims 3 and 8 further define the authorization portion of the claimed methods. Specifically, the claims provide that the advertising authorization request sent to the subscriber terminal includes a “user-selectable option” for authorizing an advertisement. In practice, the user-selectable option may allow a human user of the subscriber terminal to determine whether or not to receive the advertisements.

Blackketter does not provide any determination of whether an advertisement would be authorized nor does the reference provide any functionality for allowing a user of a subscriber terminal to select an option to authorize the advertisement. As such, dependent claims 3 and 8 provide subject matter that is patentable over Blackketter.

**e) Blackketter Does Not Teach the Claimed Triggering Event**

As amended, dependent claims 2, 7, and 11 define the triggering event as occurring when the subscriber terminal is either idle or substantially stationary. Dependent claims 5 and 9 further limits the method by defining the triggering event as occurring when the subscriber is both idle and substantially stationary.

In contrast, the Blackketter trigger includes a time attribute that prompts execution of the trigger at a future time. Blackketter, Figs. 3-6. Applicant notes that the amendments made to claims 2, 7, and 11 eliminate the time attribute (“specific time of day”) from the claimed Markush groups.<sup>1</sup>

Because Blackketter does not teach or suggest that the triggering event be when the subscriber terminal is idle and/or substantially stationary, that reference does not obviate dependent claims 2, 5, 7, 9, or 11.

## V. Conclusion

In view of the above amendments and remarks, Applicant respectfully requests reconsideration and allowance of all the pending claims. Should the Examiner have any questions, the Examiner is invited to contact the undersigned attorney at his direct dial number (312) 913-3316.

Respectfully submitted,

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<sup>1</sup> Applicant further notes that this amendment does not relinquish claim coverage to a time attribute for a triggering event as such an element is covered by the independent claims.